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| COLBERT, ELLA | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/815,422

Applicant(s)

SUZUKI ET AL.

Examiner

Ella Colbert

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-7 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-7, and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 06/23/09 (attached).

DETAILED ACTION

1. Claims 1, 5-7, and 30-33 are pending. Claims 1 and 30 have been amended in this communication filed 4/17/09 entered as Response After Non-Final Action.
2. The IDS filed 06/23/09 has been entered and considered.
3. The 35 USC 112, First Paragraph Rejection still remains as set forth her below and addressed in the section entitled "Response to Arguments".
5. The 35 USC 112, Second Paragraph Rejection still remains as set forth here below.
6. The claim for Foreign Priority has been considered but still remains as set forth here below.

Priority

Acknowledgment is made of Applicant's claim for foreign priority based on an application filed in Japan on March 24, 2000 and November 21, 2000. It is note, however, that Applicant has not filed a certified copy of the foreign filed applications as required by 35 U.S.C. 119(b). If an error has been made please contact the office. A certified copy can not be located, it is requested that the applicant refile the foreign priority documentation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 30, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 as amended recites "computing means for computing ... a weighting factor that is unique to each of the plurality of functions ...;" is not found in Applicants' specification. Claims 30 and 35 have a similar problem. Claims 5-7, 31, and 33 are also rejected because of their dependency from a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite means plus function language. This language invokes the rebuttable presumption that Applicants' seek treatment under 35 U.S.C. 112, sixth paragraph. Such treatment requires that Applicants' clearly identify particular structures or steps within the disclosure as the means for or steps for that Applicants' intend to claim (MPEP 2181). No such identification has been found, rendering the claim indefinite. For the purposes of examination below, it is assumed that Applicants' did not intend to invoke treatment under 35 U.S.C. 112, sixth paragraph. Applicants' are respectfully advised to explicitly rebut the presumption that 35 U.S.C. 112, sixth paragraph treatment has been invoked, amend the claims to remove the

invoking language, or point out language in the disclosure that clearly identifies the particular structures or steps Applicants' intend to claim. Claims 5-7, 31, and 33 are also rejected because of their dependency from a rejected claim.

Claims 1, 30, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claim 1 in order to have the claim limitations in claim 1 connected at least one claim limitation needs to have inserted at least one of the "including playback, recording, fast forwarding and rewinding". Claims 30 and 32 have a similar problem.

Claim 1 recites "function executing means for executing ... at least one of the plurality of functions designated by the operation outputting means; measuring means for measuring the time ... each of the functions has been executed;". It is unclear and vague which at least one of the plurality of functions is being referred to and which "each of the functions has been executed." Do Applicants' mean each of the functions of playback, recording, fast forwarding, and rewinding?

Claims 5-7, 31, and 33 are also rejected because of their dependency from a rejected claim.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,347,136) Horan in view of (US 6,198,915) McGregor et al, hereafter McGregor in view of (US 5,752,238) Dedrick.

Claims 1. Horan discloses, An electronic apparatus comprising:
operation inputting means for designating one of a plurality of functions, including playback, recording, fast forwarding, and rewinding (col. 3, lines 35-60); and
function executing means for executing at least one of the plurality of functions, designated by the operating input means (col. 3, lines 35-60).

Horan failed to disclose, measuring means for measuring the time during which each of the plurality of functions has been executed; computing means for computing an amount of charge by multiplying the measured execution time of each of the plurality of functions by a weighting factor that is unique to each of the plurality of functions, wherein a time unit charge decreases as the measured execution time increases and the time unit charge becomes zero when the measured execution time reaches a predetermined time value and receiving means for receiving a first key to the electronic apparatus to disable at least one of the plurality of functions, if the amount of charge is

not settled, and a second key to enable at least one of the plurality of functions if the amount of charge is settled. McGregor discloses, measuring means for measuring the time during which each of said functions has been executed (col. 3, lines 52-63 and col. 4, line 46-col. 5, line 5). Horan and McGregor failed to disclose, computing means for computing an amount of charge by multiplying the measured execution time of each of the plurality of functions by a weighting factor that is unique to each of the plurality of functions, wherein a time unit charge decreases as the measured execution time increases and the time unit charge becomes zero when the measured execution time reaches a predetermined time value. Dedrick discloses, computing means for computing an amount of charge by multiplying the measured execution time of each of the plurality of functions by a weighting factor that is unique to each of the plurality of functions, wherein a time unit charge decreases as the measured execution time increases and the time unit charge becomes zero when the measured execution time reaches a predetermined time value (col.2, line 49-col. 3, line 23 and col. 5, line 1-col. 6, line 41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Horan and McGregor with the pricing incentives of Dedrick in order to promote consuming advertisements which will subsidize the electronic content consumption fees. Since greater consumption leads to greater cost reductions and to a value of zero. McGregor further discloses, receiving means for receiving a first key to the electronic apparatus to disable at least one of the plurality of functions, if the amount of charge is not settled, and a second key to enable at least one of the plurality of functions if the amount of charge is settled (col. 3, lines 5-19, col. 10,

lines 30-33 and 48-55, and col. 18, lines 45-67). In treatment of the last limitation quoted above regarding a chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis. It would have been obvious to one having ordinary skill in the art to modify Horan as taught by McGregor to know how much time has been spend using each function and to know the amount of expected payment based on the charge for each function.

Claim 5. Horan discloses An apparatus according to claim further comprising: storing means for storing execution times for each of said functions measured by said measuring means (col. 4, lines 16-57); and transmitting means for transmitting said execution times from said storing means to an external entity for settlement of charges (col. 6, lines 24-36).

Claim 30. This independent claim is rejected for the similar rationale as given above for claims 1 and 5.

Claim 32. This independent claim is rejected for the similar rationale as given above for claims 1, 5, and 30.

Claims 6, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,347,136) Horan in view of (US 6,198,915) McGregor et al, hereafter McGregor, and (US 5,752,238) Dedrick and further in view of (US 5,956,697) Usui

Claim 6. Horan, McGregor, and Dedrick failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the amount of charge computed by the computing means; and transmitting means for transmitting the chargeable time from the storing means to an external entity for settlement of charges. Usui discloses, An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the amount of charge computed by the computing means (col. 4, lines 5-10 and col. 5, lines 16-53); and transmitting means for transmitting the chargeable time from the storing means to an external entity for settlement of charges (col. 3, lines 26-49). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have a fee-charging server that checks the access time of each device and stores the amount of time for later reconciliation of the amount of the charge (fee).

Claim 7. Horan, McGregor, and Dedrick failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of the apparatus; and settling means for subtracting a chargeable time representing the chargeable amount computed by the chargeable amount computing means, stored in the storing means, from the usable time. Usui discloses, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of the apparatus (col. 2, lines 24-43 –Summary of Invention); and settling means for subtracting a chargeable time representing the chargeable amount computed by the chargeable amount computing means, stored in the storing means, from the usable time stored in the storing means (col. 1, lines 49-67-Background of the Invention). It would

have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have the capability to settle the account by performing a mathematical process to arrive at an account settlement for each function's usage.

Claim 31. This dependent claim is rejected for the similar rationale as given above for claim 6.

Claim 33. Horan, McGregor, and Dedrick failed to disclose, A storage medium which stores a program according to claim 32, wherein the program further comprises the step of transmitting the chargeable amount to an external entity for settlement of charges.

Usui discloses, A storage medium which stores a program according to claim 32, wherein the program further comprises the step of transmitting the chargeable amount to an external entity for settlement of charges (col. 3, lines 26-49). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have the capability to settle the account by performing a mathematical process to arrive at an account settlement for each function's usage.

Response to Arguments

Applicant's arguments filed 04/17/09 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Regarding the rejection of claims 1, 5-7, and 30-33 under 35 USC 112, First Paragraph, the Examiner states that the claimed "computing means for computing ... a weighting factor that is unique to each of the plurality of functions ... is not found in Applicants' Specification has been considered but is not persuasive. Response: The sections of the Specification cited by the Applicants'

does not contain the recitations "means for computing" and "... unique to each of the plurality of functions". The "means for" or means-plus-function recitations in the claims are not found in Applicants' Specification. The "inputting means" in claim 1; "measuring means" and "storing means" in claim 5; "computing means" and "computing means" in claim 7; "execution time measuring means which"; "receiving means", and "computing means" in claim 30; and "storing means" in claim 31 and the other "means for" in the claim limitations either needs to be proper means plus function claims or amend the claims to remove the invoking language because it cannot be determined if Applicants' are attempting to invoke 35 USC 112, sixth paragraph because the language invokes the rebut table presumption that Applicants' seek treatment under 35 USC 112, Sixth Paragraph. Such treatment requires that Applicants' clearly identify particular structures or steps within the disclosure as "means for" or that Applicants' intend to claim (See MPEP 2181). No such clear identification has been cited in the sections of the disclosure referenced by the Applicants'. Claims 1, 30, and 35 were addressed in the rejection under 35 USC 112, First Paragraph and claims 1 and 30 were addressed under 35 USC 112, second paragraph rejection along with claim 32 and the dependent claims 5-7, 31, and 33 which depend from a rejected claim.

Issue no. 2: Applicants' argue: The Examiner states that Applicants' have not identified "particular structures or steps within the disclosure as the means for or steps for that Applicants' intend to claim has been considered but is not persuasive.

Response: Applicants' claim 1 should recite "operation for inputting a time for execution". Claims 5-7, 30, and 31 have a similar issue with the usage of "means".

See the response to arguments in Issue no. 1. It must be clear whether Applicants' are attempting to invoke 35 USC 112, Sixth Paragraph in the claim limitations and that clarity has not been established in the arguments section of the response to the Non-Final Office Action.

Issue no. 3: Applicants' argue: Applicants' argue: The Examiner's question as to whether Applicants' mean each of the functions of playback, recording, fast forward, and rewinding and in response Applicants' submit that the "plurality of functions" do refer to playback, recording, fast forwarding, and rewinding" has been considered. Response: Applicants' needs to put the plurality of functions include playback, recording, fast forwarding and rewinding in this claim limitation for the purpose of clarity and consistency in the claim language.

Also in claim 32 the preamble recites "A storage medium which stores a program capable of controlling a computer, the program comprising the steps of:". This claim in the preamble should recite "a storage medium which stores a program with executable instructions capable of controlling a computer, the program comprising the steps of:" In order to avoid a 35 USC 101 rejection.

Issue no. 4: Applicants' argue: Horan is silent regarding any type of charging means and McGregor does not cure the deficiencies of Horan because the phone system in McGregor does not teach or suggest measuring the time that "a plurality of functions" are exhausted and therefore, McGregor does not teach or suggest the claimed "measuring means for measuring the time during which each of the plurality of functions has been executed "as recited in claim 1 has been considered but is not

persuasive. Response: Applicants' "measuring means" and "measuring" is broad and varied. By definition "measuring" is "to choose or control with cautious restraint; b. the dimensions, capacity, or amount of something ascertained by measuring; c. an estimate of what is to be expected (as of a person or situation); d. a measured quantity (amount, degree); a standard or unit of measurement". It is unclear how the time is measured with each of the functions by execution. Is the time measured for each of the functions by the time that the functions are in use and when they are not in use?

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Issue no. 5: Applicants' argue: Applicants' respectfully assert that Usui fails to cure the deficiencies of Horan and McGregor and has failed to establish a prima facie case of obviousness with respect to claim 1 has been considered but is not persuasive. Response: The Examiner disagrees that Usui fails to cure the deficiencies of Horan and McGregor and has failed to establish a prima facie case of obviousness with respect to claim 1. Motivational statements have been given for each of the claim limitations above that require a motivational statement. Applicants' fail to appreciate the breadth of the claims. In particular, "measuring means for measuring the time during which each of said functions has been executed" and "computing means for computing ... unique to each of the plurality of functions". What makes the "... an amount of charge by multiplying the execution time of each of the plurality of functions by a weighting factor unique to each of the plurality of functions"? It is not set forth in the claim language.

Applicants' are reminded that "although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims". See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Strothmann (US 5,745,880) disclosed optimization costs of processing computer application functions.

Rakib (US 2002/0031120) disclosed a system for a wireless remote control gateway and ordering and remote control including a video display and user input device.

Ellis, H.Leon; Gouda, Saied; and Trowbridge, Scott disclosed a productivity challenge regarding a utility's reliability.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

July 27, 2009